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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,700	03/29/2004	Kazuyuki Kiuchi	Q80631	9045
65565	7590	10/18/2007	EXAMINER	
SUGHRUE-265550			FIGUEROA, JOHN J	
2100 PENNSYLVANIA AVE. NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037-3213			1796	
			MAIL DATE	DELIVERY MODE
			10/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/810,700

Applicant(s)

KIUCHI ET AL.

Examiner

John J. Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The nonstatutory obviousness-type double patenting rejection over U.S. Patent Application Numbers 10/404,861 (now issued as 7,163,597) of record in item 2 on page 2 of the Office Action of May 2, 2007 (hereinafter 'OA') has been withdrawn in view of Applicant's arguments in the response to OA filed July 31, 2007, hereinafter 'Response'.
2. The nonstatutory obviousness-type double patenting rejections over U.S. Patent Application Number 10/123,113 (now issued as USPN 7,214,424) and U.S. Patent Application Number 10/415,948 of record in item 2 on page 2 of OA have been maintained for reasons previously made of record in prior Office Actions and set forth below in item 6 of the instant Office Action.
3. The 35 U.S.C. 102(b) rejection of claims 1-7, 14 and 15 as anticipated by European Patent Application Number (EP) 1,154,002 A1 to Kiuchi et al., hereinafter 'Kiuchi', has been maintained for reasons previously made of record in item 6 on page 3 of OA.

### ***Election/Restrictions***

4. A restriction requirement was previously presented in the Office Action of June 30, 2006. Group I, claims 1-7, 14 and 15 had been elected. Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected

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invention, there being no allowable generic or linking claim in accordance with said restriction requirement.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7, 14 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 9 and 10 of U.S. Patent No. 7,214,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a heat-peelable adhesive sheet that includes a heat-expandable layer containing microspheres formed on one side of a substrate and a pressure sensitive adhesive on the other side of the substrate.

7. Claims 1-7, 14 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/415,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set of claims are drawn to a psa sheet comprising an elastic resin, a heat-peelable psa layer containing heat-expandable microspheres, wherein said layer has a surface to be adhered to an adherend.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

#### ***The Double Patenting Rejections (item 2 of OA)***

8. Applicant's arguments traversing the double patenting rejection over Application Number 10/404,861 (now USPN 7,163,597 B2) are deemed persuasive. Thus, this

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rejection has been withdrawn, particularly because of the claims of the issued patent had been amended to be drawn to a method of temporarily fixing an electronic part as opposed to a heat-peelable sheet as recited in the instant application in the instant application.

9. Applicant did not provide substantive arguments in Response with respect to the outstanding nonstatutory obviousness-type double patenting rejection over Application No. 10/415,948, previously made of record in prior Office Action. Therefore, this double patenting rejection has been maintained.

10. Applicant's arguments traversing the obviousness-type double patenting rejection over U.S. Serial No. 10/123,113 (now USPN 7,214,424 B2) have been fully considered but deemed unpersuasive. As discussed above in paragraph #5, the instant claims are drawn to a heat-peelable, pressure sensitive adhesive that encompasses the heat-peelable structure recited in the claims of the patent.

Thus, this double patenting rejection has been maintained.

*The 35 U.S.C. 102 Rejection over Kiuchi (item 6 of OA)*

11. Applicant's arguments in Response with respect to the 35 U.S.C. 102(b) rejection of claims 1-7, 14 and 15 as anticipated by Kiuchi have been fully considered but deemed unpersuasive.

Applicant's principal argument in Response traversing this anticipation rejection is that Kiuchi is disclosing the separation of the adherend from the heat-expandable adhesive layer but not between the heat-expandable adhesive layer and the substrate

upon heating. However, Kiuchi, as discussed in item 6 of OA, does disclose the same structure encompassed by the instant claims and Applicant has not provided a sufficient showing as to why the pressure sensitive adhesive layer would not be peelable from the substrate in the presence of a large amount of heat.

As stated previously on page 5 of OA, Kiuchi discloses that upon thermal treatment the microspheres are expanded and that there is a change of volume in the structure as a whole. Applicant has not shown why it would not be possible for the adhesive layer to be capable of peeling off from the substrate in Kiuchi's pressure sensitive adhesive sheet. Even if in certain circumstances the adherend will peel off from the substrate in Kiuchi's structure, this is not mutually exclusive of the adhesive layer and the substrate being heat-peelable from each other.

Thus, the instant claims remain anticipated by Kiuchi.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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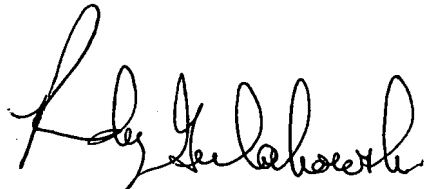
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



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